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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,125	03/30/2001	Hernan G. Otero	21710-68378	6818

28062 7590 06/27/2005		EXAMINER
BUCKLEY, MASCHOFF, TALWALKAR LLC		OYEBISI, OJO O
5 ELM STREET		

ART UNIT	PAPER NUMBER
3628	

BUCKLEY, MASCHOFF, TALWALKAR LLC
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NEW CANAAN, CT 06840

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/823,125	OTERO ET AL.
	Examiner	Art Unit	
	OJO O. OYEBISI	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>30 March 2001</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-14</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-14</u> is/are rejected.

7) ☐ Claim(s) _ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>30 March 2001</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date <u>12/03/2001</u>.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Claim Objections

1.   **Claim 7** is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim, or amend the claim to place the claim in proper dependent

form, or rewrite the claim in independent form. A proper dependent claim shall not

conceivably be infringed by anything, which could not also infringe the base claim. See

MPEP § 608.01 (n), Section III. In the instant application, the depending claim 7 recites

"The Event and Action produced by the method of claim 4." However, the claimed Event

and Action could be produced by a method other than recited in the base method claim

4. Therefore it is conceivable that the product claim 7 can be infringed without infringing

the base method claim 4. As a result, claim 7 is an improper dependent claim.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   **Claims 8-13** are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. The rejected claims appear to be directed to

computer program.

Software, programming, instructions or code not claimed as encoded on

computer-readable media are descriptive material per se and are not statutory because

they are not capable of causing functional change in a computer. When such

descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

Claims 8-13 are therefore rejected where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer. Examiner suggests that the applicant incorporate into Claims 8-13 language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   **Claim 7** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 7, the statement "The Event and Action

produced by the method of claim 4," cannot be clearly understood. The Event and

Action produced by the method of claim 4 can be anything. Therefore, the examiner

suggests that the applicant describe distinctly how claim 7 point out the subject matter

of his invention.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   **Claims 1-2, 5, 8-14** are rejected under 35 U.S.C 102(e) as being anticipated by Kane (U.S. Patent 6,317,728).

Re claim 1: Kane discloses a method for computerized trading comprising:

-   inputting a trading order into a logic engine (i.e., decision logic, see abstract).
-   using a first plug-in (i.e., agent) in said logic engine for implementing a trading strategy (see col. 5, lines 5-10).
-   inputting data for said order into said logic engine (see abstract).
-   processing the order with said logic engine, using said plug-in (see abstract).
-   executing said order (see abstract).

Re claim 2: Kane discloses a method wherein the step of inputting a trading order into a logic engine further comprises inputting an order through an ordering system (i.e., data acquisition system, see abstract).

Re claim 5: Kane discloses a method wherein the step of executing said order further comprises outputting said order through an ordering system (col. 3, lines 34-36).

Re claim 8: Kane discloses an apparatus for computerized trading comprising:
-   a logic engine for processing trading orders (see abstract);
-   an interface to said logic engine (data channel, see fig 1, elements 12, 13);

- a first plug-in (i.e., agent) in said logic engine (i.e., decision logic) for implementing a trading strategy (see col. 5, lines 5-10). Whereby said logic engine processes order received via said interface (see col. 5, lines 2-11).

Re claim 9: Kane discloses an apparatus for computerized trading comprising:
- a logic engine (i.e., decision logic) for processing trading orders (see abstract);
- a first interface (i.e., input) to said logic engine for processing orders (see abstract);
- a second interface (i.e., input) to said logic engine for processing orders (see abstract);
- a first plug-in (i.e., agent) in said logic engine for implementing a trading strategy (col. 5, lines 5-10). Whereby said logic engine processes orders received via either of said first and second interfaces (see col. 5, lines 2-8, also see abstract).

Re claim 10: Kane discloses an apparatus wherein said first interface further comprises an Input driver (i.e., agent, see col. 15, lines 5-15).

Re claim 11: Kane discloses an apparatus wherein said second interface further comprises an exchange driver (i.e., agent, see col. 15, lines 5-15).

Re claim 12: Kane discloses an apparatus wherein said first interface (i.e., input) further comprises an interface to an ordering system (see abstract).

Re claim 13: Kane discloses an apparatus wherein said second interface (i.e., input) further comprises an interface to an ordering system (see abstract).

Re claim 14: Kane further discloses an apparatus wherein said logic engine further comprises a Core Processing Area (i.e., central processing unit, see col. 5, lines 5-10).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kane

(U.S. Patent 6,317,728).

Re claim 3: Kane discloses a method wherein the step of inputting a trading

order into a logic engine further comprises inputting an order through an ordering

system (i.e., data acquisition system, see abstract). Kane does not explicitly disclose a

method wherein the step of inputting a trading order into a logic engine further

comprises inputting a complex order through an ordering system. However, since Kane

does not really distinguish between "order" and "complex order." One of ordinary skill in

the art would have obviously know that Kane system is sophisticated enough to handle

any sort of trading orders (i.e., regular or complex).

10.   **Claims 4, 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kane (U.S. Patent 6,317,728) in view of Microsoft Computer Dictionary (MCD

hereinafter: Microsoft Computer Dictionary 5th edition, page 345).

Re claim 4: Kane discloses a method for computerized trading comprising: the steps of

processing trading orders (see abstract) except for a step of de-constructing the said

Complex Order into at least one event and action. The method of deconstructing

complex order into event/action is a well-taught modular design in object-oriented

modular programming (see Microsoft computer dictionary 5th edition, page 345).

Therefore, it would have been obvious to one of ordinary skill in the art to implement this

well-taught modular design method in Kane to allow programmers to debug and recover

very quickly from program crashes.

        Re claim 6: Kane discloses a method for computerized trading comprising:

        -inputing a ComplexOrder into a logic engine through an ordering system.

- using a first plug-in (i.e., agent) in said logic engine for implementing a trading

strategy (see col. 5, lines 5-10).

- inputting data for said order into said logic engine (see abstract).

- Kane discloses a method wherein the step of executing said order further

comprises outputting said order through an ordering system (col. 3, lines 34-36).

However, Kane does not explicitly teach the step of deconstructing said complex

order into events and actions. The method of deconstructing complex order into

event/action is a well-taught modular design in object-oriented modular

programming (see Microsoft computer dictionary 5th edition, page 345).

Therefore, it would have been obvious to one of ordinary skill in the art to

implement this well-taught modular design method in Kane to allow programmers

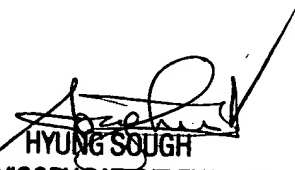to debug and recover very quickly from program crashes.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to OJO O. OYEBISI whose telephone number is (571)

272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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